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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,728

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Christian J. Lee

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AVON PRODUCTS, INC.

AVON PLACE

SUFFERN, NY 10901

EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

NOTIFICATION DATE

DELIVERY MODE

01/29/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENT.DEPARTMENT@AVON.COM

Office Action Summary	Application No. 10/721,728	Applicant(s) LEE ET AL.	
	Examiner MELISSA S. MERCIER	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 14-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11-5-09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

Receipt of Applicants Remarks and Amended Claims filed on November 5th, 2009 is acknowledged. Claims 1-31 are pending in this application. Claims 14-28 remain withdrawn from consideration. Claims 29-31 are newly added. Therefore, claims 1-13 and 29-31 are under prosecution in this application.

Information Disclosure Statement

Receipt of the Information Disclosure Statement filed on November 5, 2009 is acknowledged. A signed copy is attached to this office action.

Maintained Rejections/Objections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farer et al. (US Patent 6,156,325) in view of Kane International Disclosure of KFilm 2071, 2072, and 2073 (see attached).

Farer discloses a nail enamel composition comprising film forming substances, including nitrocellulose, as a primary film former, and polyurethane, as a secondary film former. Film forming substances are present in the amount of 5-20% by weight relative to the weight of the composition. Modifiers for the primary film forming agent include aryl sulfonamide resins, including epoxy resins (column 4, lines 11-33).

Plasticizers are also present in the amount of 3-12% of the formulation (column 4, lines 34-49).

Solvents are present in the amount of 40-80% by weight relative to the total weight of the composition (column 4, lines 57-60).

Coloring agents can also be added (column 4, lines 61-65).

Farer does not disclose the high molecular weight and glass transition temperature of the polyurethane in the instant claims.

Kane International has been marketing the high molecular weight polyurethane resins disclosed in the instant specification, known as KFilm 2071, 2072, and 2073 since 1984 according to the manufacturer who was contacted by the Examiner on July 30, 2009. Applicant has indicated that the resins meet the functional limitations of the

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instant claims. Applicant has further identified these resins by Trade name in the specification indicating they were commercially available prior to the filing date of the invention.

It would have been obvious to one of ordinary skill in the art to have used the Film products in the composition of Farer since Kane International discloses that they are excellent film forming resins having excellent adhesion and bond strengths.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues:

***Farer's objective is not to provide transfer resistance and physical properties of a dried nail coating composition but to thicken a liquid nail enamel composition to improve its ability to spread on the nail.**

It is respectfully submitted that the prior art need not recognize the same advantages as those disclosed in the prior art. The prior art reference of record utilizes polyurethane as a resin component. The cited secondary references disclose the advantages of those particular polyurethane references. Therefore, the skilled artisan would have recognized that they could be incorporated/substitutes into the formulation of Farer in order to obtain the disclosed advantages.

Applicant's arguments regarding "unexpected results" pertaining to the dry nail polish are not persuasive. There is no evidence of unexpected results obtained regarding the inclusion of the polyurethane used which is not disclosed as an "expected result" from their respective disclosures.

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***The MSDS's of KFILM 2071, 2072, and 2073 all disclose toxicological concerns and that the film formers would not be expected to be suitable for use in cosmetic formulations.**

This argument appears to be in contradiction to Applicants response to the Request for Information in which Applicant responds that Polyurethane-8 is a well known cosmetic resin. It is noted on the Information supplied by Applicant that polyurethane-8 is also known by the Trade name KFILM 2071.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,656,483.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims comprise a species of the polyurethane resin of the instant claims, namely, the patented claims limit the polyurethane to a polyurethane resin having a weight average molecular weight about 20,000 to about 80,000 and a glass transition temperature of about -4 to -20C, whereas the instant claims expend the range of the glass transition temperature to -4 to -40C. Additionally, the patented claims require the inclusion of one or more arylsulfonamide epoxy resins, however, the instant claims use the terminology comprising allowing for such an inclusion.

Response to Arguments

Applicant has committed to filing a Terminal Disclaimer upon the indication of allowable subject matter. Until the time of such a filing, the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax can be reached on (571) 272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/Robert A. Wax/
Supervisory Patent Examiner, Art Unit 1615